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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,419	09/25/2003	Hirotsugu Muratsu	242941US3	5063
30671	7590	05/04/2006	EXAMINER	
DITTHAVONG & MORI, P.C. 10507 BRADDOCK ROAD SUITE A FAIRFAX, VA 22032			KIM, JOHN	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/669,419	Applicant(s) MURATSU, HIROTSUGU	
	Examiner John Kim	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Examiner's notes

Applicant cancels claims 1-10 and presents new claims 11-20.

Priority

Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 12/9/02 and 3/28/03. It is noted, however, that applicant has not filed a certified copy of both applications 2002-356605 and 2003-89831 (respectively) as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitations "the value" and "the spacing" in the section starting with "a first indicator" and "a second indicator". There is insufficient antecedent basis for this limitation in the claim.

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Claim 16 recites the limitation "its surface remote" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The applicant is reminded when reciting a new limitation into the claims, the limitation begins with the words "a" or "an," and all subsequent recitations of the limitation should be begin with the words "the" or "said."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-15 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ashby et al. (US Pat 5,911,723 June 15, 1999).

In regards to claims 11 and 15, Ashby teaches of an apparatus having a base (1), a first engaging member (3), a moving body (4), second engaging member (5), moving member (33), driving member (17), a locking member (18), a first indicator (33), and a second indicator (9 and 11). Please see Ashby figure 3. Ashby also teaches a second tissue engaging means on a rotatable shaft, thus being able to rotate on the axis substantially parallel with respect to the osteotomized surface at the femoral distal end (column 4 lines 23-25). Lastly, Ashby teaches of using femoral component. He discusses the prosthetic components to be positioned at 90 degrees to the coronal and sagittal planes (column 3 lines 54-67). He also points out the importance of maintaining

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the balance of the patello-femoral articulation, where the size of the femoral component is based on the correct anterior cut. (column 7 lines 65-67) Furthermore, Ashby shows the engaging members having an offset structure with respect to the base and moving body. The limitation of offset is described as something that balances or compensates or is away from the centerline of a body. With a centerline (using the shaft (24) as a reference line), then engaging members are offset from the rest of the invention. In regards to the performing of patella eversion, it is noted that the invention is in regards to an apparatus or device. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. (See MPEP 2114)

In regards to a portion of claims 11 and 15 and all of claims 12 and 18, Ashby teaches an apparatus with a driving and locking members performed by a rack and pinion geared drive with a ratchet lever and ratchet wheel. This allows the tissue engaging means to be displaced from each other. The tissue engaging means will not move towards each other without releasing the ratchet lever (column 4 lines 40-53).

For claims 13 and 19, Ashby teaches that the shaft is provided with graduations to measure the gap distance (column 5 lines 26-31).

With regards to claims 14 and 20, Ashby teaches his apparatus of having a ligament balance meter read from a scale on a plate (columns 6 lines 52-62 and column 6 line 66- column 7 line4).

Allowable Subject Matter

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Since applicant cancels all previous claims (1-10), any arguments or remarks are considered moot. Remarks about the new claims are responded above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK 


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER